

Application No.: 10/676,873
RCE Submission dated March 24, 2008
Reply to Final Office Action and Advisory Action

Docket No.: COTH-P01-002

REMARKS

The Advisory Action mailed on October 16, 2007 indicates that the claim amendments filed on September 24, 2007 have been entered, and rejections based on 35 U.S.C. §§ 101 and 112, second paragraph have been withdrawn. Thus, Claims 1, 3-5, 7-13, 15, 16, 21-24, 27-33, 35, and 56 are pending. Among them, Claims 2, 17-20, 36-55, and 57-68 are directed to non-elected invention, and were canceled without prejudice.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the Office Action.

Claim rejections under 35 U.S.C. § 112, first paragraph - enablement

Claims 1, 3-5, 7-16, 21-24, 27-35, and 56 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Office Action argues that the enablement rejection is based on the full consideration of the *Wands* factors, and that ‘although the level of skill in molecular biology is high, the results of experiments in genetic engineering are unpredictable.’ The Office Action continues to rely on Ginalski, and argues that “the instant claims do not recite any limitation drawn to an assessment of sequence homology, nor do the instant claims require any requisite level of sequence homology between the ‘spacially conserved motif’ and the ‘recipient polypeptide’ as instantly claimed.”

The Examiner appears to hold the view that the claimed invention is directed to a foolproof method of engineering any and all spatially conserved protease motif into any and all recipient polypeptide. In an attempt to clarify the issue, Applicants’ attorneys Matt Vincent and Yu Lu conducted a phone interview with Examiner DeJong on March 24, 2008. Applicants’ attorneys wish to thank the Examiner for participating in the interview and providing constructive suggestions during the interview. The instant response also constitutes the required statement under 37 C.F.R. § 1.133(b).